

REMARKS

This is intended as a full and complete response to the Final Office Action dated March 10, 2006, having a shortened statutory period for response set to expire on June 10, 2006. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-24, 50-55, 57, 60, 61, 70-82, and 94-99 remain pending in the application and are shown above. Claims 1-24, 50-55, 57, 60, 61, 70-82, and 94-99 are rejected by the Examiner. Reconsideration of the rejected claims is requested for reasons presented below.

35 U.S.C. § 103

Claims 1-5, 8-15, 18, 19, 21-24, 50-55, 57, 60, 61, 70-82, and 94-99 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *McArthur* (US 4,652,195) in view of *Kelly* (US 3,881,375). The Examiner states "*Kelly* has been used to teach the use of a wellbore tong system on the end of an extendable structure." The Examiner further states that because *Kelly* teaches a separate wrenching apparatus, it provides the motivation for combining *Kelly* and *McArthur*" as a positionable tong would eliminate the need for a separate wrenching apparatus."

Applicant respectfully traverses this rejection. The Federal Circuit recently reemphasized that the U.S. Patent and Trademark Office bears the burden of establishing a case of *prima facie* obviousness. *In Re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). *In Re Dembiczak* requires the Examiner to *particularly* identify any suggestion, teaching, or motivation from within the references to combine the references.

Neither references teach, show, or suggest positioning the apparatus on a drilling tower. *McArthur* discloses a casing stabbing apparatus assembly positioned on a rig floor for engaging a median portion of a suspended casing, and thereafter swing or move the casing to more precisely align the casing over another casing. The stabbing apparatus cannot make up or break out the casings. In fact, the casings are made up in

a separate step. (Col. 6, Ins. 52-59). Referring to Figure 1, an operator is shown standing on the rig floor using a wrenching apparatus to make up the casings. Thus, *McArthur* actually teaches away from the combination because it teaches using a wrenching apparatus to make up the tubular instead of the stabbing apparatus.

Kelly discloses an apparatus having a tong assembly T supported on a vertical column having a base support. The tong assembly is connected to a tong supporting yoke structure 24, which is mounted on the collar 20 of the column and is not extendable. *Kelly* does not teach stabbing the pipe sections using the tong assembly. *Kelly* addresses the problem of positioning the tong assembly such that the gripping mechanism is adapted to engage the respective joint sections 26b and 30b of the pipe joint J. As such, it would not have been obvious to a person of ordinary skill in the art to combine the tong of *Kelly* with the positioning apparatus of *McArthur* located on the derrick because the *Kelly* tong on the derrick would be out of alignment with the joint sections that are located near the rig floor. Moreover, neither reference teaches using the tong to "stab" in the tubular. Thus, contrary to the Examiner's suggestion, combining the references to arrive at a "positionable tong" would NOT reduce the equipment necessary because a separate stabbing apparatus on the derrick would still be required to align the tubulars for connection. Therefore, no motivation or suggestion exists to combine the references. Thus, the Examiner has merely used hindsight based on the Applicant's disclosure to piece together various prior art in order to render the Applicant's claimed invention obvious. The references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure, wherein the mounting assembly includes a bearer and the bearer is coupled to a single location of a support member on a drilling tower, as recited in claim 1. Also, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly for coupling the extendable structure to at most one location on a drilling tower, as recited in claim 50. Additionally, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly having a bearer adapted to couple the apparatus to a single location on a drilling tower, as recited in claim 70. Further, the references, neither alone nor in combination, teach, show, or suggest a mounting assembly coupled to an opposite end of the extendable structure,

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wherein the mounting assembly is adapted to couple the extendable structure to a single location of a support beam disposed above a rig floor, as recited in claim 76. Withdrawal of the rejection is respectfully requested.

Claims 6, 7, 16, 17, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *McArthur* in view of *Kelly* as applied to claims 5 and 15 above, and further in view of *Swoboda, Jr., et al.*

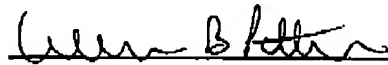
Claims 6-7, 16-17, and 20 depend from claim 1. As discussed above, Applicant believes claim 1 is in condition for allowance. Therefore, Applicant also believes claims 6-7, 16-17, and 20 are in condition for allowance. Withdrawal of the rejection is respectfully requested.

Conclusion

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed.

Having addressed all issues set out in the office action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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